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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,577	06/09/2000	Charles A. Eldering	T702-03	2970
27832	7590	05/02/2006	EXAMINER	
TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME			RETTA, YEHDEGA	
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SUITE 208			ART UNIT	PAPER NUMBER
DOYLESTOWN, PA 18901			3622	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/591,577

Applicant(s)

ELDERING ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 86-121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 86-121 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/6/ 2/14/06</u> | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Response to Amendment*

This office action is in response to amendment filed February 6, 2006. Applicant amended claims 86, 92, 98, 103, 109, 110 and 115 and canceled claims 76-85. Claims 86-121 are currently pending.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 86-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite a first set of consumers and retrieving demographic information for a second set of consumer, wherein there is overlap between the first set and second set of consumers; applying heuristic rules for a third set of consumers wherein the set of consumers includes a subset of the first set of consumers; and driving a fourth set of consumers likely to be interested to a particular advertisement wherein the fourth includes consumers within the third set. All these steps are not taught in applicant's specification. Applicant's specification teaches generating subscriber profiles from transaction and demographic information, however does not teach taking the steps recited in the claims. Applicant is required to amend the claims to reflect

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what is disclosed. If applicant is convinced that the disclosure discloses the steps claimed then applicant should point out the correlation of the claimed feature with the disclosure.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 86-121 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 86 recites, “wherein the operator includes at least one discretionary element of interest to an advertiser, wherein the at least one discretionary element is not directly identifiable from consumer transaction records and the at least one discretionary element is not representative of a single purchasing element”. Applicant does not define what other purchasing segments are known and what are not being used in the marketing or advertisement field. So it is unclear to the Examiner what the discretionary element is representative of. The claim indicates that the element is not directly identifiable from customer’s transaction records, so the assumption is that the element could be directed to demographic record. However Examiner could not understand what a single purchasing segment is. The specification does not provide any example nor does it provide information on what the discretionary element is representative of. Examiner’s understand of the term “operator” is a computer instruction.

Claim 92 recites, “discretionary element includes a selection of target market characteristics not typically associated with item being advertised”.

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Claims 93 and 94 recite “consideration not representative of any particular group of present consumers of the item”.

Claim 95 recites, “target market characteristics are not representative of actual consumers of the item”.

Claim 96 recites, “target market characteristics are not representative of actual existing market”.

Claim 97 recites, “target market characteristics are not representative of a single purchase segment”.

Claim 109 recites, “the discretionary elements include target market characteristics which need not be representative of an actual existing market or single purchase segment”.

Claim 110 recites, “wherein the heuristic rules associated the consumer purchase transaction and the consumer transaction attributes to non-transaction related consumer attributes”, “to generate non-transaction related consumer attributes”.

Claim 115 recites, “includes at least one of consumer transaction records, demographic information, and non-transaction related attributes”, “wherein the heuristic rules associate the consumer transaction records and to non-transaction related attributes”, “wherein the advertisement profile includes a selection of target market characteristics not typically associated with item being advertised”.

All the negatively claimed limitation, in light of applicant’s disclosure, could not be determined as to what those terms encompass.

All dependent claims are rejected as being dependent to rejected claims.

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Examiner understanding or interpretation of the term “discretionary element”, which is not directly identifiable from customer’s transaction record, is demographic data such as the age group, income, location, etc, of the potential customers.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 86-121 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al. (US 6,463,585).

Regarding claims 86-88, Hendricks teaches retrieving consumer transaction records for a set of consumers from plurality of purchases; retrieving demographic information of the consumer; creating profiles for each subset or group of consumer which are a subset or subgroup of a first group (subscribers) and applying to a subset of the consumer transaction records for a group or a subset of the subscribers (customers) likely to be interested in a particular

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advertisement wherein the operator (computer instruction) includes at least one discretionary element which is not directly identifiable from consumer transaction records and is not representative of a single purchasing segment, wherein application of the operator produces a targeted list of consumer having the specific discretionary element of interest to the advertiser (see col. 20 lines 4-48, col. 26 line 42 to col. 27 line 6, col. 29 lines 1-44, col. 35 lines 1-28, col. 66 line 35 to col. 67 line 4, lines 52-62, col. 76 line 66 to col. 77 line 23, col. 78 line 44 to col. 79 line 4). Since the discretionary element, demographic data such as age or income or gender, is not directly identifiable from consumer transactions it is also not representative of a purchasing segment.

Regarding claim 89, Hendricks teaches the demographic information includes information retrieved from combination of public and private database (see col. 11 lines 31-40, col. 29 lines 6-32).

Regarding claims 90, Hendricks teaches wherein demographic information is probabilistic (see col. 66 line 58 to col. 67 line 4).

Regarding claim 91, Hendricks teaches demographic information is associated with particular geographic regions (see col. 5 lines 1-14, col. 26 lines 54-67, Table D, Table E).

Regarding claims 92-99, 103-109, 113-121, Hendricks teaches selecting a set of consumers (individual or groups) from a plurality of consumers; retrieving at least one discretionary element for an advertisement, wherein the at least one discretionary element includes one or more target market characteristics not typically associated with item being advertised (demographic data); performing a linear operation on a database having a demographic and transaction information to determine applicability of the advertisement to a set

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of consumers; wherein the target market characteristics include a set of demographic and product preference; including demographic groups; correlating the discretionary element and the demographic and transaction information contained in the consumer database for the set of consumers; applying heuristic rules to generate discretionary elements (see col. 4 lines 12-17, col. 5 lines 1-52, col. 11 lines 25-50, col. 20 lines 4-67, col. 26 line 42 to col. 27 line 6, col. 29 lines 1-44, col. 30 lines 21-53, col. 31 lines 27-55, col. 66 line 36 to col. 67 line 4, lines 34-62).

Regarding claims 100-102, Hendricks teaches wherein the set of consumers are identified anonymously (see col. 44 lines 7-67).

Regarding claim 110, Hendricks teaches retrieving consumer transaction records for a set of consumers from plurality of purchases; retrieving demographic information of the consumer; creating profiles for each subset or group of consumer which are a subset of subgroup or a first group (subscribers) and applying heuristic rules to a subset of the consumer transaction records for a group or a subset of the subscribers (customers) to generate discretionary elements and deriving a set of consumer likely to be interested in a particular advertisement (see col. 20 lines 4-48, col. 26 line 42 to col. 27 line 6, col. 29 lines 1-44, col. 35 lines 1-28, col. 66 line 35 to col. 67 line 4, lines 52-62, col. 76 line 66 to col. 77 line 23, col. 78 line 44 to col. 79 line 4).

Claim 110 is rejected as stated above in claim 76.

Regarding claim 111, Hendricks teaches query the consumer database in controlled manner to prevent in appropriate measurements from being made (see col. 35 to col. 38 line 59).

Claim 112 is rejected as stated above in claim 100.



*Response to Arguments*

Applicant's arguments filed February 6, 2006 have been fully considered but they are not persuasive.

In regard to applicant's argument that it is unclear to which aspects of the claims appear to the Examiner to be unsupported by the specification, the Examiner disagrees. It is clearly pointed out by the examiner the part of the claimed feature that the examiner considers to be unsupported by the specification. To help the applicant the examiner highlighted the section as shown above. Applicant intends to argue that it is well known in the art that marketers subdivide consumer into groups, subgroups, sets, markets, submarkets and so forth, for the purpose of study, analysis, categorization and marketing efforts. The test is not whether it is obvious or not to one of ordinary skill in the art. Applicant also argues that it is implicit in the concept of a subgroup, or set, moreover that two or more subgroups, or sets may overlap one another. Examiner does not believe that every subgroups created by marketer would create an overlap between the subgroups. Therefore, it is not inherent that every subgroup created would overlap one another. Applicant's statement proves that the specification does not implicitly or inherently teach the claimed feature.

Examiner disagrees regarding applicant's argument of 112 second paragraph rejection. As stated before the claims rejected under 112 second paragraph include claim language that states what the term does not represent or is not associated with. For example regarding the claim limitation that states that the target market characteristics are not representative of actual existing market. In order for the Examiner to understand what the target market characteristics are the Examiner need to understand what the Applicant considers an actual existing market is.

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Applicant states that the discretionary market segments are defined by characteristics chosen at the discretion of a marketer and applicant states that the boundaries of the term “discretionary element” are clearly defined. Examiner would like to ask the applicant to point out how is the boundaries defined. How possibly can the examiner search for a prior art if the examiner has no idea what applicant intended scope of the claim is, since there is no limit to the characteristics that can be chosen at the discretion of a marketer. As point out before, Applicant is required to clearly and definitely point out and distinctly claim the subject matter which applicant regards as the invention. Thus the rejection of 112 first and second paragraphs still applies.

Applicant argues that Hendricks teaches viewers arranged according to a group assignment plan based upon factors such as area of dominant influence, ZIP code, and household income and advertisement being selected based upon viewer-based data only as “correlation algorithms”. Applicant argues that Hendricks being silent with respect to how the correlation algorithms work. Applicant argues Hendricks does not disclose applying an operator to create a subset of interested consumers, the use of discretionary element generally, nor specifically, the use of discretionary elements that are neither directly identifiable from consumer transaction records nor representative of a single purchasing segment. Applicant admits that dividing consumers into subgroups (sets), it is implicit in the concept of a subgroup, or set, moreover that two or more subgroups, or sets, may overlap one another. If that is the case, the examiner then believes that Hendricks also teaches overlapping since Hendricks also divides customers into groups or sets, based on viewing habits, also based on information supplied by the customer from survey or questionnaire. The advertisement is selected to be presents to groups or viewers who are likely to be interested, same as applicant’s invention. Therefore the discretionary

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element of interest to the advertiser, as best understood by the examiner is the demographic information of the customer, such as age, gender, income, viewing habit, etc. Applicant's specification (par. 161) as also indicated by Applicant. Applicant cites the "(b)ecause advertisements can be targeted based on a set of demographic and product preference considerations which may not be representative of any particular group of present customers of the product, the ad characterization vector can be set to identify a number of demographic groups which would normally considered to be uncorrelated. *Because the ad characterization can have target profiles which are not representative of actual consumers of the product, the ad characterization vector can be considered to have a discretionary element.* Hendricks also teaches ad characteristics which can be set to identify a number of demographic groups which are not representative of the actual consumers of the product, since the ad is selected based on the customer demographic information or viewing information, not no customer's purchase history of the advertised product.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RETTA YEHDEGA  
PRIMARY EXAMINER

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